

REMARKS**I. General**

Claims 1-20 are pending in the present application. Claims 9-15 stand rejected under 35 U.S.C. § 101. Claims 1-20 stand rejected under 35 U.S.C. § 103. Applicant respectfully traverses the rejections of record.

II. Consideration of the References Submitted in the Information Disclosure Statement

Applicant notes the Examiner's admonition that the information disclosure statement filed February 5, 2003 fails to comply with 37 C.F.R. § 1.98(a)(2). However, the Examiner has not provided any guidance as to how the information disclosure statement does not comply with 37 C.F.R. § 1.98(a)(2). Applicant believes that all requirements of 37 C.F.R. § 1.98(a)(2) have been met with respect to the information disclosure statement filed February 5, 2003. However, applicant has attached another copy of the references to an information disclosure statement include with this response for the Examiner's convenience. Applicant respectfully requests that the Examiner consider the references or provide specific guidance with respect to how Applicant has failed to meet the requirements of 37 C.F.R. § 1.98(a)(2).

III. The 35 U.S.C. § 101 Rejections

Claims 9-15 stand rejected under 35 U.S.C. § 101 because the "claims describe a claim that could be performed by hand by a human being, and lack a technological basis such as a computer that is required to be statutory subject matter," see the Office Action at page 2. In rejecting these claims, the Examiner does not identify any authority upon which the rejection is based, but rather baldly asserts that the process recited therein lacks a technological basis such as a computer that is required to be statutory subject matter.

Applicant has reviewed 35 U.S.C. § 101 and is unable to identify any portion of the statute which requires anything further than a "process" for claims 9-15 to fall into a statutory class of subject matter. The Examiner has not asserted that these claims are not a process, and therefore appears to be in agreement that the claims recite a process. Applicant respectfully asserts that claims 9-15, reciting a process, comprise statutory subject matter under 35 U.S.C. § 101.

Although the Examiner asserts that a technological basis such as a computer is required to make claims 9-15 fall into a statutory class of subject matter, such does not appear to be the law. Processes as statutory subject matter have a very early history in United States patent law. For example, although not expressly including “processes” in the definition of statutory subject matter, the phrase “any art” as included in the Patent Act of 1793 was interpreted to encompass processes, see e.g., *Corning v. Burden*, 56 U.S. (15 How.) 252 (1853). Clearly a computer could not have been required in order for a process to be considered statutory subject matter before the twentieth century.

Moreover, the Court expressly stated

A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. If new and useful, it is just as patentable as is a piece of machinery.

Cochrane v. Deener, 94 U.S. 780, 787-788 (1877). There is nothing to suggest that anything other than an act or series of acts is necessary for a process to be statutory subject matter. When the judicial precedent for processes being included in the patentable subject matter was codified in the Patent Act of 1952, no requirement for anything other than a process was set forth in the statute, just as none exists today under 35 U.S.C. § 101. Accordingly, Applicant respectfully asserts that claims 9-15 set forth a patentable process which comprises statutory subject matter under 35 U.S.C. § 101. Applicant respectfully requests that the Examiner withdraw the rejection of claims 9-15 under 35 U.S.C. § 101 or provide specific guidance as to the authority for the rejection so that Applicant may understand how to properly redress the rejection.

IV. The 35 U.S.C. § 103 Rejections

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lapierre, United States patent number 6,075,550 (hereinafter *Lapierre*), in view of DeStefano, United States patent number 6,184,885 (hereinafter *DeStefano*). Claims 2-5, 7, 10-12, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of Cragun et al., United States patent number 5,832,212 (hereinafter *Cragun*). Claims 6, 13, and 20 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Aras et al.*, United States patent number 5,757,417 (hereinafter *Aras*). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Halim et al.*, United States patent number 6,304,881 (hereinafter *Halim*). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of *Dieterman*, United States Patent number 6,393,464 (hereinafter *Dieterman*). Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Dieterman*.

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the references lack proper motivation to combine in addition to lacking all the claim limitations.

Independent claim 1 recites “[a] computerized document censor comprising . . . a text comparator program for finding ones of said restricted terms in said document” Similarly, independent claim 9 recites “[a] method for censoring a document comprising . . . filtering said document to find ones of said prohibited expressions” Independent claim 16 recites “[a] computer program product . . . for reviewing a document for restricted expressions comprising . . . means for searching said document to find ones of said restricted expressions” The rejection of record relies upon the disclosure of *Lapierre* in meeting the foregoing aspects of the claims, see the Office Action at page 3.

Lapierre does not teach or suggest censoring a document or finding restricted terms or expressions in a document. In contrast to the above identified claim language, *Lapierre* teaches a censor device which deletes words contained within the text data signal provided from a closed caption component of a video signal, see column 2, lines 45-54. The disclosure of *Lapierre* does not provide any hint or suggestion of finding restricted terms in a document, nor has the Examiner asserted otherwise. Moreover, the disclosure of *DeStefano*, nor any of

the other references of record, is not relied upon in the rejection of record to cure the above identified deficiency. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 1, 9, and 16 and the claims dependent therefrom.

The rejection of record for claims 1, 9, and 16 concedes that *Lapierre* does not meet the limitation reciting “a text highlighter program for highlighting said restricted terms found in said document.” Accordingly, the rejection of record relies upon the disclosure of *DeStefano*, stating that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have highlighted words with a special condition in *Lapierre* in the manner of *DeStefano* in order to draw attention to them.” However, it must be borne in mind that the express purpose of the closed caption censor of *Lapierre* is to “remov[e] objectionable language from the closed caption and audio portions of programming displayed on a television,” column 1, line 67, through column 2, line 2, such as to “regulate the programming content seen by children,” column 1, line 14. However, rather than removing the objectionable language, as required for the principle of operation of *Lapierre*, the modification proposed by the Examiner would highlight the objectionable language “in order to draw attention to them.” One of ordinary skill in the art would not have been led to draw the attention of a viewer, such as a child, to highlighted objectionable text in the closed captioning displayed by *Lapierre*.

As discussed above, the disclosure of *Lapierre* teaches away from displaying objectionable language, whether highlighted or otherwise. “It is improper to combine references where the references teach away from their combination,” M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the invention being modified in the applied art, then the teachings of the references are not sufficient to render the claims *prima facie* obvious, M.P.E.P. § 2143.01, citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959). As discussed above, the principle of operation of *Lapierre* is to remove objectionable language. This principle of operation would be changed by highlighting objectionable language as proffered in the rejection of record.

Accordingly, Applicant asserts that a *prima facie* case of obviousness under 35 U.S.C. § 103 over *Lapierre* and *DeStefano* has not been established with respect to claims 1, 9, and 16 and the claims dependent therefrom. Moreover, the rejections of record relying upon

various combinations of *Lapierre*, *DeStefano*, *Cragun*, *Aras*, *Halim*, and *Dieterman* do not cure the above identified deficiency in the *prima facie* case of obviousness.

V. Summary

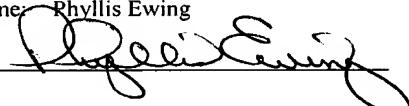
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004840-1 from which the undersigned is authorized to draw.

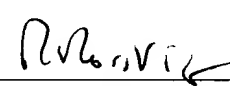
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